

REMARKS

Claims 1-7 were examined, with claims 8-11 having been withdrawn pursuant to a restriction requirement. All claims were rejected for the reasons discussed more fully below. The claims have been amended as noted above. Reexamination and reconsideration of the claims, as amended, are respectfully requested.

As an initial matter, Applicants have canceled the non-elected claims without prejudice refiling in a subsequent application.

The objection to the Drawings has been overcome by submission of new Fig. 3B. Fig. 3B is a detailed view taken directly from Fig. 3, except that the axial bore 34 has been shown with an exaggerated taper number 35. No new matter has been added. The Specification has been amended to conform to the addition of Fig. 3B. As the drawings now show the claimed taper, the objection over 37 C.F.R. § 1.83(a) should be withdrawn.

The Specification has been updated to note the status of Parent Application 08/942,990, as U.S. Patent No. 6,007,516.

Applicants note that they have not become aware of any errors in the Specification as of this time.

The rejection of claims 5 and 6 as being indefinite has been overcome by the amendment of these claims. In particular, claim 5 has been amended to state that it is the "latch" which comprises the pair of balls. Claim 6 has been amended to recite that the "valve assembly comprises a valve selected from the group consisting of" It is believed that these amendments overcome the indefiniteness noted by the Examiner.

Claims 1-2 and 6 were rejected as being anticipated by the Flaherty '363 patent. Such rejections are traversed in part and overcome in part.

Applicants believe that independent claim 1, even prior to amendment, distinguished the teachings of Flaherty. The recitation of a lock having "a latch which shifts position to lock the valve assembly open" is believed to patentably distinguish the teachings of Flaherty '363. The assembly of elements 220', 233 and 248 relied on by the

Examiner, would correspond to the valve assembly "having a bore" as set forth in claim 1 of the present application. There is no latch since the only thing which holds the valve open is the needle 240 itself. In Fig. 2, there is nothing which even holds the valve open and it appears that the valve would close of its own spring force if inward pressure on the needle 240 were relieved.¹

In an effort to expedite prosecution in this present application, however, Applicants have amended claim 1 to further recite that the latch locks the valve assembly open in response to movement of the access tube "prior to seating of the access tube in the bore of the valve assembly." Such a latch is contraindicated by Flaherty '363 where the needle must seat in the needle-receiving bore in order to initially open the valve 246.

For these reasons Applicants believe that the rejection based upon Flaherty '363 has been overcome.

Applicants have also added new independent claim sets 12-17 and 18-22. Independent claim 12 incorporates the limitations previously found in dependent claim 4 (with minor edits to conform them more closely to the language of the independent claim). As dependent claim 4 was not rejected over the art, Applicants believe that independent claim 12 clearly distinguishes the teachings of Flaherty '363. Similarly, new independent claim 18 incorporates the limitations previously set forth in dependent claim 5. As dependent claim 5 was not rejected over the art, Applicants believe that new independent claim 18 distinguishes the Flaherty '363 patent.

Claims 1-3 and 6 were rejected as being anticipated by Ensminger '451. Such rejection is traversed in part and overcome in part.

Even prior to the amendment of claim 1, Applicants believe that recitation of the valve lock "having a latch which shifts position to lock the valve assembly open...." clearly distinguished the teachings of Ensminger '451. While the structure of Ensminger fortuitously includes structure 28 which moves laterally when a needle is

¹ While the port of Figs. 1 and 1A show a "retention piece 236 which holds the needle in place," there is no equivalent structure identified in the embodiment of Fig. 2. Moreover, a retaining ring which holds the needle in place is hardly equivalent to the latch of the present invention.

positioned through the valve 4 (assuming for the sake of argument only that the needle could open the structure), these elements in no way act as a latch to hold the valve open. The only thing holding the valve open is the presence of the needle between the two halves of the valve structure holding them open. There is simply no latch.

The amendment to claim 1 even further distinguishes the teachings of Ensminger '451. There is no structure, latch or otherwise, in Engsminger '451 which would lock the valve assembly open prior to seating of the access tube, i.e. needle, in the bore of the valve assembly. Again, as discussed above, it is only the presence of the needle in the valve structure, as shown in Fig. 25, which holds the valve open. There is no latch.

Applicants further note that new claims 12-22 incorporate subject matter which was not rejected over Ensminger.

Claim 7 was rejected as being obvious over Flaherty optionally in view of White '882. Without conceding the correctness of such rejection, Applicants will rely on the allowability of independent claim 1 as discussed above.

Applicants have submitted a Terminal Disclaimer, thus obviating the rejection for non-statutory double patenting.

In view of the above amendments and remarks, Applicants believe that all pending claims are now in condition for allowance and request that the application be passed to issue at an early date.

Attached is a marked-up version of the changes made by the current amendment. The attached page is captioned with "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

JEFFREY H. BURBANK et al.
Application No.: 09/431,008
Page 9

PATENT

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (650) 326-2400.

Respectfully submitted,

James M. Heslin
Reg. No. 29,541

Attachment: *Exhibit A*

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
JMH:ao
PA 3230580 v1

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

First paragraph on page 1, lines 3-6, of the Specification:

The present application is a continuation-in-part of non-provisional Application Serial No. 08/942,990, filed on October 2, 1997, (now U.S. Patent No. 6,007,516, issued December 28, 1999), which claimed the benefit of provisional Application Serial No. 60/036,124, filed on January 21, 1997, the full disclosures of which are incorporated herein by reference.

On page 8, line 28 through page 9, line 6:

The base 12 of access port 10 comprises an upper shell 18, a base plate 20, an internal cylinder 22, and a vertically reciprocating plunger 23 disposed within an actuator block 24, where the assembly of the plunger and actuator block are together disposed within the cylinder 22. As shown in Figs. 2 and 2A, a spring 26 urges the plunger 23 and actuator block 24 upwardly relative to the base 20. When the plunger 23 and actuator block 24 are in their upward position, the conduit 14 is pinched closed between an upper lip 28 which is a portion of the wall of cylinder 22 and a lower lip 30 which is portion of the actuator block 24. A proximal end of the conduit 14 is connected to the lower end of a tube 32 which depends into an interior volume of the actuator block 24. The depending tube 32 provides an axial bore 34 for receiving a needle N, as illustrated in Figs. 3 and 3A. A tapered region 33 is formed near the upper end of axial bore 34 and is sized to engage and seal against the outer side wall of a needle or other access tube which is introduced into the bore, as best seen in Fig. 3B.

Page 9, line 32 through page 10, line 3:

In a preferred aspect of the access port 10 of the present invention, the axial bore 34 will be tapered in the downward direction, as best seen in Fig. 3B over region 33. The size of the bore and degree of the taper will be selected to frictionally

engage conventional needles or other access tubes so that a tight seal is formed as the access tubes are inserted into the axial bore 34. The taper also provides a stop so that the needle N will not penetrate into the horizontal lumen defined by the conduit 14.

IN THE CLAIMS:

1. (Amended) An implantable port comprising
a base having a passage for receiving an access tube;
a valve assembly in the base, said valve assembly having a bore which
receives the access tube and wherein the valve assembly opens in response to movement
of the access tube;
a valve lock having a latch which shifts position to lock the valve
assembly open in response to movement of the access tube prior to seating of the access
tube in the bore of the valve assembly.

5. (Amended) An implantable port as in claim 3, wherein the latch
[valve lock] comprises a pair of balls which are displaced laterally.

6. (Amended) An implantable port as in claim 1, wherein the valve
assembly comprises a valve [is] selected from the group consisting of pinch valves,
sliding valves, slit valves, duckbill valves, and leaflet valves.